

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated February 27, 2003. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

Status of the Claims

Claims 1-20 are under consideration in this application. Claims 1-12 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicants' invention. Claims 13-20 are being added to recite another embodiment described in the specification.

Additional Amendments

The claims and the Abstract are being amended to correct formal errors and/or to better disclose or describe the features of the present invention as claimed. All the amendments to the claims are supported by the specification. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

Formality Rejection

The Examiner declined to enter the Preliminary Amendment on the grounds that the subject matter to be amended should have been presented in English. Claims 1, 2, 5, 9 and 12 were objected due to various informalities. The language and format of the abstract were objected to and the Examiner has requested correction thereof. As indicated, the claims and the Abstract have been cancelled or amended as required by the Examiner. Accordingly, the withdrawal of the outstanding formality rejection is in order, and is therefore respectfully solicited.

Allowable Subject Matter

Claims 11-12 will be allowed if they rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 11 is being rewritten in independent form to include all of the limitations of the base claim and any intervening claims such that they are in condition for allowance.

Prior Art Rejections

Claim 1-4 and 6-10 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,148,331 by Parry (hereinafter "Parry") on the grounds that the reference shows the claimed elements of the present application. The prior art references of Swinehart (6,360,951), Russell et al (5,905,248), Cragin et al (5,804,803), and Wellner (5,640,193), and United Kingdom patent GB 2,327,565 (hereinafter "GB'565") A were cited as being pertinent to the present application. This rejection has been carefully considered, but is most respectfully traversed.

The system (Fig. 1) for reading display information according to the invention, as now recited in claim 1, comprises: an information display member **A** (e.g., a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a card, a handbill, tissue papers, an ad hung down in trains, a mascot doll, etc., page 15, lines 5-19); and at least one mobile communication terminal (page 20, line 3-4) of a **public mobile communication system B** (e.g., a PDC, CDMA, or GMS system, page 21, lines 5 and 9, including at least one mobile phone) for reading at least a portion of the display information G (e.g., text, image, and audio page 16, last paragraph) displayed on said information display member A. The information display member comprises an information recording element **R** (e.g., a IC chip **S** or a bar code **T**) in which necessary and/or optional information of the information portion is stored; said mobile communication system **B** comprises a reader mechanism **V** for reading information recorded in said information recording element **R** and a display mechanism **E** for displaying the read information; and the information recorded in said information recording element R including said portion of the display information G displayed on said information display member A. In particular, the information display member (e.g., a poster) physically displays information perceivable and desired by a person who would otherwise write down the information of interest on a memo pad (page 2, line 18) but for the availability of the invention.

As shown in Fig. 3, the information recorded in said reader mechanism is transferred via a net line of a LAN (claim 4) to be recorded in a personal computer **I** or a server system **H** (Claim 5). The mobile communication system includes a mobile phone (Figs. 1 and 4; claim 13). The reader mechanism reads information from the information recording element in a contact or non-contact manner (Fig. 5; claim 14). The bar code is a stack type bar code or a data matrix bar code (page 14, line 15; claim 15), and the IC chip includes a coil antenna (page 11, line 13; Figs. 7 and 13; claims 16-17). The mobile communication system further comprises reading-out means for reading the text information into voice (page 26, 1st paragraph; claim 18) to serve blind people.

Applicants respectfully contend that neither Parry nor any of the other cited references, teaches or suggests such a dual-purpose mobile communication terminal of a public mobile communication system, e.g. embodied in a mobile phone, which not only (1) reads an information portion **G** (e.g., text, image, and audio) of in an information display member but also (2) functions as a mobile terminal of a public mobile communication system for wireless voice communication.

In contrast, the communication system in Parry constituted by PCs and the internet is NOT capable of moving or of being moved readily from place to place during the regular operation of the system. The scanning pen 100 in Swinehart does communicate with the computer 200 via infrared, radio or cable connection (col. 2, lines 48-50). However, it does not function as a mobile phone for wireless communication. The scanner pen 11 in Wellner shares the same problem since it does not do not function as a mobile phone for wireless voice communication. Although Wellner's scanner pen 11 wirelessly communicates via link 12 with a user interface unit 15 (e.g., a set-up box) (col. 2, lines 43-46), it does not wirelessly communicate with the communication network 14 or the telephone 19a (Fig.1) as a mobile phone for wireless voice communication. The bar code scanner 7 (Fig. 1), the remote control scanning device 18 (Fig. 2), the internet scanning terminal 26 (Fig. 3), and the bar code scanning unit 70 (Fig. 4) in Russell do not function as a mobile phone.

As to GB'565, it concerns a mobile user terminal for accessing a data file stored in a server via a wireless communication link (page 2, lines 23-30) which "*includes a means for reading a network address (e.g. URL) identifying the data file from a machine readable label*" tagged on an article, such as an item on sale, a museum exhibit, a stop, or a station. The only information recorded in the tagging devices 100-130 is a URL of a webpage "*containing information related to the article*" (page 9, line 27-28, such as a museum exhibit, an item for sale, or a stop, or a station) which does NOT including any portion of display information displayed on the article. It was commonly known that a museum exhibit, an item for sale, a stop, or a station did not display a URL

in 1997 when GB'565 was filed. Therefore, GB'565 fails to teach or suggest "the information recorded in said information recording element including said portion of the display information displayed on said information display member" (last sentence of claim 1).

GB'565 does not involve any information display member (e.g., a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a card, a handbill, tissue papers, an ad hung down in trains, a mascot doll, etc.) which physically displays information of interest and perceivable by human according to the invention. The only information read by the user terminals 70-90 from tagging devices 100-130 is a URL which is NOT physically displayed on an article tagged with the tagging device. The timetable in GB'565 shall not be confused with the timetable of the invention. In the invention, the timetable itself is an information display member displaying the actual bus or train schedule of interest (page 1, line 20; page 15, lines 8-9). In GB'565, although the timetables shall be displayed in the stops or stations, GB'565 generally tags the tagging devices anywhere in the stops or stations (rather than right on the timetables) which sufficiently allows the travelers to retrieve the timetable included in the URL (page 9, lines 13-18). Therefore, the timetable in GB'565 is not a information display member (e.g., a poster) which physically displays information perceivable by human, and the information is only later read by the reader means.

Further more, the user terminals 70-90 of GB'565 are used as "portable web browsing devices (page 9, line 30)" in a defined private wireless network 60 in a shop (page 8, line 32). Or a museum (page 9, line 9). In particular, a customer to the shop or a visitor to the museum is **supplied** by the shop or the museum one of the user terminals 70-90 "*to access from the internet 10 information relating to selected item on sale*(page 8, lines 35-36)" or "*the exhibit* (page 9, line 9-11)." Even the user terminals 70-90 equipped by the travelers in stops and stations of a public transport network (page 9, lines13-18) were not specified as mobile communication terminals of a public mobile communication system. GB'565 only concerns **private/confined** (rather than **public**) mobile communication system.

Applicants respectfully remind the Examiner that any reliance upon the "common knowledge and common sense" of one skilled in the art for the motivation for combining the teachings in the references shall fulfill the agency's obligation to cite references to support its conclusions by pointing out the specific teaching, e.g. *statements in the prior art*, of allegations of the combination on the record to allow accountability.

*To establish a prima facie case of obviousness, the Board must, inter alia, show
"some objective teaching in the prior art or that knowledge generally available to*

one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “*The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.*” Kotzab, 217 F.3d at 1370, 55 USPQ2d at 1317. Recently, in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), we held that the Board’s reliance on “common knowledge and common sense” did not fulfill the agency’s obligation to cite references to support its conclusions. Id. at 1344, 61 USPQ2d at 1434. Instead, the Board must document its reasoning on the record to allow accountability. Id. at 1345, 61 USPQ2d at 1435.

See In re Thrift, 298 F.3d 1357.

Applicants contend that none of the cited prior references teaches or discloses each and every feature of the present invention as disclosed in independent claim 1. As such, the present invention as now claimed is distinguishable and thereby allowable over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of

the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

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